

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Eric C. Anderson et al.

Examiner: Yogesh K. Aggarwal

Serial No. 09/213,131

Art Unit: 2622

Filed: 12/15/1998

Attorney Docket No. 1104-069/P126C

For: METHOD AND APPARATUS FOR CORRECTING ASPECT RATIO IN A CAMERA
GRAPHICAL USER INTERFACE

**RESPONSE TO DECISION DISMISSING
A PETITION UNDER 37 § 1.182 TO EXPUNGE CONFIDENTIAL MATERIAL**

Attn: Pinchus M. Laufer
Mail Stop: Office of Legal Administration
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Honorable Commissioner:

This is a Response to a Decision, mailed November 29, 2012, dismissing a recently filed petition under §1.182 to expunge Confidential Business Information (CBI). The original IDS inadvertently included documents that were designated as Confidential Business Information ("CBI") pursuant to the Protective Order in International Trade Commission ("ITC") Investigation No. 337-TA-726 ("726 Investigation").

I. TERMINOLOGY (ORIGINAL, DE-DESIGNATED, AND REMAINING CBI)

Some materials that were originally designated as CBI ("original CBI") under the 726 Investigation Protective Order have been recently "de-designated" ("de-designated CBI") by the parties who produced the materials. As such, the de-designated CBI is no longer subject to the 726 Investigation Protective Order.

The remaining materials previously identified as CBI ("remaining CBI") under the 726 Investigation Protective Order are still subject to the 726 Investigation Protective Order. Patent Owner respectfully requests that this remaining CBI be expunged from the Patent Office records.

II. 10 RELATED CASES (SIMILAR ISSUES)

The above-mentioned matter corresponds to one of the following 10 reexaminations, applications and patents: 95/001,431; 95/001,420; 95/001,433; 90/010,834; 90/012,200; 90/012,090; 11/963,018; 09/213,131; 11/466,629; and 11/512,575.

To keep the record clear, expungement in 11/466,629 was initially granted on November 13, 2012, but this expungement was promptly withdrawn in an Office Communication mailed on November 29, 2012.

The petitions to expunge in the above 10 cases were all dismissed on November 29, 2012.

III. BACKGROUND

For the convenience of the Patent Office, a summary of recent submissions is provided below. As a preliminary matter, Attorney Pinchus Lauffer of the USPTO Office of Patent Legal Administration has verbally stated that the non-patent literature associated with the above-identified cases (including all original CBI) is currently flagged so that it is not available to the public, pending the outcome of these petitions.

- A. Patent Owner filed a Petition Under §1.182 to Replace the Original IDS (so as to expunge the inadvertently included CBI from the PTO's records).
- B. Patent Owner filed a corresponding Petition to Expedite.
- C. HTC filed a "Statement in Support" of the above petitions on September 19, 2012.
- D. Patent Owner filed a "First Supplemental Letter" clarifying that at least one document inadvertently included in the IDS and designated as CBI had been designated as confidential by Patent Owner.
- E. Patent Owner filed a "Second Supplemental Letter" specifically identifying a document that had been produced by HTC and designated by HTC as CBI under the 726 Investigation Protective Order and requesting that this specific document be expunged from the IDS and the PTO's records on an expedited basis.
- F. On September 6, 2012, Patent Owner requested information from the Office of General Counsel regarding any requests for certified prosecution histories of the 10 related cases. Such a request is the only way that a member of the public would be able

to access non-patent literature associated with any of the impacted cases, including any of the documents that were designated as CBI and inadvertently included in the original IDS. On October 4, 2012, the Office of the General Counsel replied, indicating that 7 of the 10 related cases had each received one request, and that the remaining 3 cases had received no requests.

G. Patent Owner filed a “Third Supplemental Letter” stating which materials originally designated as CBI under the 726 Investigation Protective Order have recently been de-designated as CBI (or, to put it another way, have been designated as non-confidential). Patent Owner submitted Exhibit B, listing all of the original CBI, and highlighting all of the de-designated CBI. Specifically, Exhibit B is a list of all references that were originally designated as CBI, and therefore were originally subject to the 726 Investigation Protective Order. The materials on that list that have since been de-designated as CBI (and can now be publicly disclosed) are highlighted in green and are no longer subject to the 726 Investigation Protective Order. The materials that are not highlighted are still designated as CBI (remaining CBI), remain subject to the Protective Order, and should be expunged from the PTO records. Exhibit B is attached again for the convenience of the examiner.

IV. STATEMENT “NOT OTHERWISE MADE PUBLIC”

A. PROBABLE STATEMENT BY HTC

The recent Dismissal, at page 2, second paragraph, requires that HTC state on the record “that the document has not otherwise been made public.” HTC has told Patent Owner that it will timely respond to the PTO, but to date Patent Owner has not seen any such statement from HTC. HTC may make such a statement directly to the Patent Office.

B. STATEMENT BY APPLE (ATTACHED)

Apple is making such a statement regarding the remaining CBI belonging to Apple (and regarding three expert statements). This statement is attached as Exhibit R-2.

Expert statements are made with reference to CBI belonging to all parties, and may include portions of CBI belonging to all parties. Thus, it is difficult to define ownership of expert statements.

C. PROBABLE STATEMENT BY KODAK

To date, Patent Owner has not seen a signed statement from Kodak. Kodak may make such a statement directly to the Patent Office.

D. STATEMENT BY FLASHPOINT

FlashPoint hereby states that, to its knowledge, aside from the limited ITC and PTO disclosure discussed below, the remaining CBI belonging to Flashpoint has not otherwise been made public.

V. DISCUSSION OF ITC AND PTO LIMITED DISCLOSURES

On the evening of August 9, 2012, FlashPoint was first informed that the file wrapper for the '190 Patent, which was submitted to the International Trade Commission (ITC) as part of a complaint for patent infringement, contained confidential business information. On the morning of August 10, 2012, FlashPoint contacted the office of the Secretary of the ITC to request that certain parts of the file wrapper submitted with the complaint be treated as confidential. The ITC immediately removed the confidential portions of the file wrapper from public access. The same day, FlashPoint's litigation counsel reached out to FlashPoint's prosecution counsel to arrange for the return of any confidential materials. FlashPoint then requested that its prosecution counsel commence proceedings to expunge all confidential materials from the PTO records. Prosecution counsel then contacted the PTO to determine the best course of action to expunge confidential materials from the PTO records and began preparations to file the instant petitions to expunge. Also on August 10, FlashPoint contacted counsel for all respondents in the 850 Investigation to confirm they would treat the identified CBI that had been inadvertently disclosed as confidential under the 850 Protective Order.

FlashPoint has contacted both the Secretary of the ITC and the Patent and Trademark Office to determine whether any member of the public not subject to a protective order in either the 726 or 850 ITC Investigations has had access to the inadvertently disclosed confidential documents. FlashPoint learned that copies of the file wrappers from the following applications were ordered on behalf of firms representing Respondents in ITC Investigations 337-TA-726 and 337-TA-850: Application Nos. 95/001431; 95/001420; 95/001433; 90/010834; 90/012200; 90/012090; 09/213131. FlashPoint asked those firms to confirm the destruction of all confidential information contained in those file wrappers by both the firms and the vendors used to obtain the file wrappers. To-date, FlashPoint knows of no disclosure through the ITC or

through the PTO of the inadvertently disclosed confidential business information to any member of the public not subject to the protective order.

VI. CLEARLY IDENTIFYING REMAINING CBI (EXHIBITS B1 AND R1)

As a preliminary matter, Patent Owner submits Exhibit B1. Exhibit B1 is an updated version of Exhibit B (previously provided), and includes corrections of several typographical errors.

The recent Dismissal, at page 2, third paragraph, states that Patent Owner “has not properly identified the remaining documents by clearly associating the documents that have been recently de-designated with the information disclosure statement, entry number and document description.” Page 7 of the Dismissal states “[p]atent owner must provide a statement clarifying for which documents expungement is requested, provide a clear listing identifying those documents...”

Patent Owner respectfully attaches Exhibit R-1, a detailed listing of all original, de-designated, and remaining CBI. Specifically, the columns include: Description in IDS, Bates Numbers (where applicable), S8/98a Form and number, PDF file name, and number of pages. Similar to Exhibit B1, de-designated CBI has been highlighted, and remaining CBI is not highlighted.

Patent Owner requests that all remaining CBI (all non-highlighted CBI in Exhibit R1) be expunged.

VII. EXPERT REPORTS (UNDEFINED OWNERSHIP)

The “expert reports” are subject to the ITC protective order, but are not clearly owned by any single party. For the sake of expungement, it should be noted that three of these expert reports are identified in Apple’s declaration.

VIII. RELIEF REQUESTED

Patent Owner requests that all remaining CBI (designated as CBI under the 726 Investigation Protective Order and not de-designated) be permanently expunged from the Patent Office Records.

Patent Owner further reiterates its prior requests that the current “freeze” on public access to non-patent literature (which includes all of the original CBI) associated with the above-identified cases be maintained in the above-identified matter until the Petitions to Replace are fully decided.

Patent Owner will assist in any process that the Patent Office determines is appropriate for expunging the remaining CBI from the IDS and records. For example, after the Patent Office makes a final determination, Patent Owner is willing to file a redacted IDS that reflects the final determination.

VIII. CONCLUSION

The Office is invited to direct any questions or comments regarding this matter to the undersigned at the below-listed telephone number, facsimile number, or e-mail address.

The Commissioner is hereby authorized to charge any fees that may be required, or credit any overpayment, to Deposit Account No. 50-1732.

An early and favorable action is hereby requested.

Respectfully submitted,

/Ed Garcia-Otero/
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Exhibit B1: List of all original CBI, with de-designated CBI highlighted.

Exhibit R-1: Table 1 detailed listing all of the original, de-designated, and remaining CBI.

Exhibit R-2: Statement by Apple, “not otherwise been made public.”